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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,843	07/16/2003	Shaun Jeffrey Hensley	005127.00349	8804
22909	7590	04/22/2005	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			BROWN, JAYME L	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,843

Applicant(s)

HENSLEY ET AL.

Examiner

Jayme L. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-35, 38 and 39 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14-28, 30-31, 36-37, and 40 is/are rejected.
- 7) ☐ Claim(s) 9, 13, and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/30/03 & 11/19/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 12/30/03 and 11/19/04 have been considered by the examiner. The following foreign patents were not considered: 181938 (Austria); 1,195,549 (France); 2,144,464 (France); 2,407,008 (France); G9201758.4 (Germany); and EPO 0,094,868 because of failure to comply with 37 CFR 1.98(a)(3) since a concise explanation of the relevance was not included, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 34'. **Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application.** Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the

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filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The use of the trademarks PELLETHANE®, ELASTOLLAN®, and ESTANE® have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

On page 4, lines 17-18 of paragraph 11 in the Specification, PELLETHANE®, ELASTOLLAN®, and ESTANE® all appear without the trademark symbol (®).

Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: On page 12, line 8 of paragraph 59, it appears that "central area 42," should be changed to - - central area 41 - - and "column 43" should be changed to - - column 34 - -.

On page 23, line 3 of paragraph 91, "first surface 131" should be changed to - - first side 131 - - to keep consistent with how the item was previously described.

On page 25, line 3 of paragraph 97, "bladder 40'." should be changed to - - chamber 40' - - to keep consistent with how the item was previously described.

On page 25, line 3, "chamber 47'" should be changed to - - chamber 40' - -.

On page 25, line 4 of paragraph 97, it appears that "Figure 26" should be changed to - - Figure 25 - - since there is no Figure 26 and Figure 25 is the only drawing that depicts the parting line 133.

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8, 11, 14, 31, 36-37 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 27-28, and 36-37 are confusing because it is unclear how the parting line can be extended. Clarification and appropriate amendment is required.

Claims 11, 14, 31, and 40 are confusing because it is unclear what these three different portions of the parting line are and what parts they represent in Figure 25 where the parting line 133 is depicted. It appears applicant is attempting to claim the non-linear wave-like pattern of the parting line described in paragraph 97 of the

Specification. It is recommended that the claims be amended to express that the parting line 133 follows a non-linear course having a wave-like pattern.

Inquiry Under 35 U.S.C. §102(f)

7. Swigart et al. (US 2005/0011085 A1) is the publication of application 10/620,837. Swigart et al. was filed on the same day as the present application and has substantially the same specification and figures as the present application. Swigart et al. has claims directed solely to the product and the present application has claims directed solely to the method of making the product. Both Swigart et al. and the present application are assigned to Nike, but have no common inventors. An official inquiry is hereby made pursuant to MPEP 2137 to verify the inventorship of the present application is correct. MPEP 2137 states as follows:

“Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in reply to an inquiry regarding the appropriate inventorship under subsection (f), or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct

in that the reference discloses subject matter invented by the applicant rather than derived from the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. In re Katz, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship, and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the...inventor" of the subject matter disclosed in the article and claimed in the application)."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Gasbarro (U.S. Patent 4,829,682).

Regarding claim 21, Gasbarro teaches a method of manufacturing a fluid filled chamber for an article of footwear comprising the steps of positioning a parison between a first portion and a corresponding second portion of a mold wherein the parison has a first side that faces the first portion and a second side that faces the second portion; bending the parison with contours of the mold as the first portion and second portion translate toward each other; shaping the parison to define a first surface, a second

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surface, and a sidewall of the chamber wherein at least a first area of the sidewall being formed from the first side, the first area extending from the first surface to the second surface, and at least a second area of the sidewall being formed from the second side, the second area also extending from the first surface to the second surface; and bonding the first side of the parison to the second side of the parison to form a parting line (Column 2, line 29 – Column 3, line 11; Figure 6). It is noted that both sides meet to form a sidewall with a parting line in the center. Gasbarro anticipates claim 21.

Regarding claim 26, Gasbarro teaches that the step of shaping involves forming the chamber such that at least one surface of the chamber has a curved configuration (Figures 3 and 4).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-8, 11, 21-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swigart (U.S. Patent 6,457,262) in view of Gasbarro (U.S. Patent 4,829,682).

Regarding claim 1, Swigart is directed to a fluid-filled chamber (bladder) for an article of footwear as depicted in Figure 3A (See Abstract). Swigart teaches that the

conventional blow molding process is one method for making the bladder (Column 5, lines 25-27).

Gasbarro is an example of such a conventional blow molding process wherein a parison is positioned between first and second portions of a mold, the parison is bent to conform with the contours of the mold as the first and second portions of the mold translate toward each other, the opposite sides of the parison are shaped to form the chamber, and the opposite sides of the chamber are bonded together (Column2, line 29 – Column 3, line 11; Figure 6). One skilled in the art would have readily appreciated making the bladder of Swigart using a conventional blow molding process would involve the steps detailed in the conventional blow molding process of Gasbarro. It would have been obvious to one of ordinary skill in the art to use the conventional blow molding method exemplified in Gasbarro in the method of Swigart.

One skilled in the art would have readily appreciated that a conventional blow molding process would require the mold to correspond to the shape of the desired bladder. One skilled in the art would have readily recognized that a mold used to make the bladder depicted in Figure 3A would require the mold portions to have a cavity which would correspond to the ultimate shape of the bladder, and the contours of the mold would be outside the cavity. It would have been obvious to one of ordinary skill in the art at the time the invention was made that using a conventional blow molding process in the method of Swigart would require mold portions that have a cavity and contours positioned separate from the cavity.

Regarding claim 21, Swigart is silent towards the sidewall being formed from both sides; however, such is conventional in blow molding as shown for example in Gasbarro where the two sides meet to form a sidewall with a parting line in the center. It would have been obvious for both sides to form the sidewall in the method of Gasbarro.

Regarding claims 2-3 and 22-23, Swigart and Gasbarro are relied upon for the teachings above in reference to claims 1 and 21. Swigart is silent toward the mold having protrusions formed on one of the first portion and the second portion and having indentations formed in the other of the first portion and the second portion wherein the indentations are positioned to receive the protrusions and that the indentations and protrusions are separate from the areas of the mold that form the chamber. It is well known and conventional to have a mold with protrusions on one portion and indentations on the other portion wherein the indentations are positioned to receive the protrusions and that they are separate from the area of the mold that forms the chamber depicted by Swigart. One skilled in the art would readily appreciate needing a mold with an area that contains indentations and protrusions to form the conduit (20, 30) parts and a different area that forms the chamber that is shown by Swigart (Figure 3A). At the time the invention was made, it would have been obvious to one of ordinary skill in the art that using the conventional blow molding process of Gasbarro in the method of Swigart would require using a mold with indentations and protrusions separate from the area that forms the chamber, since it is a conventional mold to use to form a chamber (bladder).

Regarding claims 4 and 24, it is well known and conventional that bending the parison would include extending it around the protrusions and into the indentations of the mold. One skilled in the art would readily appreciate that if a mold with indentation and protrusions is used to shape the parison, then the parison would extend into the indentations and around the protrusion. At the time of the invention, it would have been obvious that the parison would extend around the protrusions and into the indentations in the method of Swigart as modified above.

Regarding claims 5 and 25, Swigart and Gasbarro are relied upon for the teachings above in reference to claims 1 and 21. Swigart is silent toward the step of shaping including forming the chamber having a plurality of lobes that extend outward from a central area of the chamber. It is well known and conventional that a chamber could have lobes that extend outward from the central area as depicted by Swigart (Figure 3A). One skilled in the art would readily appreciate having a chamber with lobes for better fluid flow and stabilization (Swigart: Column 3, lines 38-53). At the time of the invention, it would have been obvious to one of ordinary skill in the art that using the conventional blow molding process of Gasbarro in the method of Swigart would require having a chamber with lobes.

Regarding claim 6, it is well known and conventional that the step of shaping involves forming the chamber such that at least one surface of the chamber has a curved configuration as shown for example by Gasbarro (Figures 3 and 4).

Regarding claims 7-8, 11, 27-28 and 31, it is well known and conventional that the step of bonding includes defining a parting line between opposite sides of the

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parison and extending the parting line from a first surface to an opposite second surface of the chamber as shown for example by Gasbarro (Figure 2, item 17; Column 2, line 29 – Column 3, line 11).

Regarding claim 26, Gasbarro teaches that the step of shaping involves forming the chamber such that at least one surface of the chamber has a curved configuration (Figures 3 and 4).

12. Claims 10, 12, 14-20, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasbarro (U.S. Patent 4,829,682) in view of Swigart (U.S. Patent 6,457,262), as applied to claims 1-8, 11, and 21-28 above, and further in view of Tawney et al. (U.S. Patent 6,571,490).

Regarding claims 10, 12, 14, and 30, Gasbarro and Swigart are relied upon for the teachings above in reference to claim 1 and 21. Gasbarro is silent towards a portion of the parting line being non-centrally located with respect to a first surface to an opposite second surface of the chamber. It is well known and conventional to have a non-centrally located parting line on the chamber as suggested by Tawney et al. One skilled in the art would readily appreciate having a non-centrally located parting line for aesthetic purposes and to increase the life of the chamber (bladder) by moving it away from areas of predicted high stresses (Column 21, lines 7-18; Figure 49, item 450). At the time of the invention, it would have been obvious for one of ordinary skill in the art to

have a non-centrally located parting line in the method of Gasbarro, as modified above, as suggested by Tawney et al.

Regarding claim 15 and 16, Gasbarro, Swigart, and Tawney et al. are relied upon for the teachings above in reference to claim 12. Swigart is silent toward the mold having protrusions formed on one of the first portion and the second portion and having indentations formed in the other of the first portion and the second portion wherein the indentations are positioned to receive the protrusions and that the indentations and protrusions are separate from the areas of the mold that form the chamber. It is well known and conventional to have a mold with protrusions on one portion and indentations on the other portion wherein the indentations are positioned to receive the protrusions and that they are separate from the area of the mold that forms the chamber depicted by Swigart. One skilled in the art would readily appreciate needing a mold with an area that contains indentations and protrusions to form the conduit (20, 30) parts and a different area that forms the chamber that is shown by Swigart (Figure 3A). At the time the invention was made, it would have been obvious to one of ordinary skill in the art that using the conventional blow molding process of Gasbarro in the method of Swigart would require using a mold with indentations and protrusions separate from the area that forms the chamber, since it is a conventional mold to use to form a chamber (bladder).

Regarding claims 17 and 18, it is well known and conventional that bending the parison with the protrusions and indentations would also include extending it around the protrusions and into the indentations. One skilled in the art would readily appreciate

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that if a mold with indentation and protrusions is used to shape the parison, then the parison would be bent by the protrusions and indentations and also extend into the indentations and around the protrusion. At the time of the invention, it would have been obvious that the parison would be bent by the protrusions and indentations and also extend around the protrusions and into the indentations in the method of Swigart as modified above.

Regarding claim 19, Gasbarro, Swigart, and Tawney et al. are relied upon for the teachings above in reference to claim 12. Swigart is silent toward the step of shaping including forming the chamber having a plurality of lobes that extend outward from a central area of the chamber. It is well known and conventional that a chamber could have lobes that extend outward from the central area as depicted by Swigart (Figure 3A). One skilled in the art would readily appreciate having a chamber with lobes for better fluid flow and stabilization (Swigart: Column 3, lines 38-53). At the time of the invention, it would have been obvious to one of ordinary skill in the art that using the conventional blow molding process of Gasbarro in the method of Swigart would require having a chamber with lobes.

Regarding claim 20, it is well known and conventional that the step of shaping involves forming the chamber such that at least one surface of the chamber has a curved configuration as shown for example by Gasbarro (Figures 3 and 4).

Allowable Subject Matter

13. Claims 32-35 and 38-39 are allowed.

14. Claims 9, 13, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 9, 13, and 29, the prior art of record fails to suggest that the parting line is in a non-linear configuration wherein the term "non-linear" is understood to mean that the parting line is in a wave-like pattern and therefore not in the same plane as depicted in Figure 25. Regarding claims 32-35 and 38-39, the prior art of record fails to suggest that in the step of shaping the parison, the first side and the second side are interlaced to form at least a portion of a sidewall of the chamber.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are U.S. patents that were mentioned in the Specification, but were not listed in the IDS: Rudy (4,340,626) and Bonk et al. (6,082,025; 6,127,026; 6,203,868; and 6,321,465). They have been listed on form PTO-892.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jayme L. Brown** whose telephone number is **571-272-8386**. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN T. HARAN
PRIMARY EXAMINER